

## **I. APPLICATION ENTITLED TO FILING DATE**

The mailing of a "Notice of Omitted Item(s)" will permit the applicant to:

(A) promptly establish prior receipt in the USPTO of the page(s) at issue. An applicant asserting that the page(s) was in fact received by the USPTO with the application papers must, within 2 months from the date of the "Notice of Omitted Item(s)," file a petition under 37 CFR 1.53(e) with the petition fee set forth in 37 CFR 1.17(f), along with evidence of such deposit (37 CFR 1.181(f)). The petition fee will be refunded if it is determined that the page(s) was in fact received by the USPTO with the application papers deposited on filing. The 2-month period is not extendable under 37 CFR 1.136;

(B) promptly submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant desiring to submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date must, within 2 months from the date of the "Notice of Omitted Item(s)," file any omitted page(s) with an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to such page(s) and a petition under 37 CFR 1.182 with the petition fee set forth in 37 CFR 1.17(f), requesting the later filing date (37 CFR 1.181(f)). The 2-month period is not extendable under 37 CFR 1.136; or

(C) accept the application as deposited in the USPTO. Applicant may accept the application as deposited in the USPTO by either:

(1) not filing a petition under 37 CFR 1.53(e) or 37 CFR 1.182 (and the required petition fee) as discussed above within 2 months of the date of the "Notice of Omitted Item(s)". The failure to file a petition under 37 CFR 1.53(e) or 37 CFR 1.182 will be treated as constructive acceptance by the applicant of the application as deposited in the USPTO. The application will maintain the filing date as of the date of deposit of the application papers in the USPTO, and the original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the USPTO on the date of deposit. Amendment of the specification is required in a nonprovisional application to renumber the pages consecutively and cancel any incomplete sentences caused by the absence of the omitted page(s). Such amendment should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application, or

(2) filing an amendment under 37 CFR 1.57(a). If an application was filed on or after September 21, 2004, and contains a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application that was present on the filing date of the application, and the omitted portion of the specification was inadvertently omitted from the application and is completely contained in the prior-filed application, applicant may submit an amendment to include the inadvertently omitted portion of the specification pursuant to 37 CFR 1.57(a). Such amendment should be by way of a preliminary amendment and the preliminary amendment must be submitted within 2 months from the date of the "Notice of Omitted Item(s)."

The amendment should be identified as an amendment pursuant to 37 CFR 1.57(a) and must comply with the requirements of 37 CFR 1.57(a) and 37 CFR 1.121. See MPEP § 201.17. The application will maintain the filing date as of the date of deposit of the original application papers in the USPTO. The original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the USPTO on the original date of deposit. The 2-month period is not extendable under 37 CFR 1.136.

Any petition under 37 CFR 1.53(e) or 37 CFR 1.182 not filed within the 2-month period set in the "Notice of Omitted Item(s)" may be dismissed as untimely. 37 CFR 1.181(f). Under the adopted procedure, the USPTO may strictly adhere to the 2-month period set forth in 37 CFR 1.181(f), and dismiss as untimely any petition not filed within the 2-month period. This strict adherence to the 2-month period set forth in 37 CFR 1.181(f) is justified as such applications will now be forwarded for examination at the end of the 2-month period. It is further justified in instances in which applicant seeks to submit the omitted page(s) in a nonprovisional application and request the date of such submission as the application filing date as: (A) according the application a filing date later than the date of deposit may affect the date of expiration of any patent issuing on the application due to the changes to 35 U.S.C. 154 contained in Public Law 103-465, § 532, 108 Stat. 4809 (1994); and (B) the filing of a continuation-in-part application is a sufficiently equivalent mechanism for adding additional subject matter to avoid the loss of patent rights.

The submission of omitted page(s) in a nonprovisional application and acceptance of the date of such submission as the application filing date is tantamount to simply filing a new application. Thus, applicants should consider filing a new application as an alternative to submitting a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(f)) with any omitted page(s), which is a cost effective alternative in instances in which a nonprovisional application is deposited without filing fees. Likewise, in view of the relatively low filing fee for provisional applications, and the USPTO's desire to minimize the processing of provisional applications, the USPTO will not grant petitions under 37 CFR 1.182 to accept omitted page(s) and accord an application filing date as of the date of such submission in provisional applications. The applicant should simply file a new completed provisional application.

Applications in which a "Notice of Omitted Item(s)" has been mailed will be retained in OIPE for a period of 2 months from the mailing date of the notice. Nonprovisional applications that are complete under 37 CFR 1.51(b) will then be forwarded to the appropriate Technology Center for examination of the application. Provisional applications that are complete under 37 CFR 1.51(c) will then be forwarded to the Files Repository. The current practice for treating applications that are not complete under 37 CFR 1.51(b) and (c) will remain unchanged (37 CFR 1.53(f) and (g)).

## II. APPLICATION NOT ENTITLED TO FILING DATE

If the application does not contain anything that can be construed as a written description, OIPE will mail a Notice of Incomplete Application indicating that the application lacks the specification required by 35 U.S.C. 112. Applicant may:

(A) file a petition under 37 CFR **1.53(e)** with the petition fee set forth in 37 CFR **1.17(f)**, asserting that (1) the missing specification was submitted, or (2) the application papers as deposited contain an adequate written description under 35 U.S.C. **112**. The petition under 37 CFR **1.53(e)** must be accompanied by sufficient evidence (37 CFR **1.181(b)**) to establish applicant's entitlement to the requested filing date (e.g., a date-stamped postcard receipt (MPEP § **503**) to establish prior receipt in the USPTO of the missing specification);

(B) submit the omitted specification, including at least one claim in a nonprovisional application, accompanied by an oath or declaration in compliance with 37 CFR **1.63** and 37 CFR **1.64** referring to the specification being submitted and accept the date of such submission as the application filing date; or

(C) submit an amendment under 37 CFR **1.57(a)**. If an application was filed on or after September 21, 2004, and contains a claim under 37 CFR **1.55** for priority of a prior-filed foreign application, or a claim under 37 CFR **1.78** for the benefit of a prior-filed provisional, nonprovisional, or international application that was present on the filing date of the application, and the specification was inadvertently omitted from the application and is completely contained in the prior-filed application, applicant may submit an amendment to include the inadvertently omitted specification pursuant to 37 CFR **1.57(a)**. The amendment must be accompanied by a petition under 37 CFR **1.57(a)(3)** along with the petition fee set forth in 37 CFR **1.17(f)**. See MPEP § **201.17**. The amendment should be identified as an amendment pursuant to 37 CFR **1.57(a)** and must comply with the requirements of 37 CFR **1.57(a)** and 37 CFR **1.121**. The 2-month period is not extendable under 37 CFR **1.136**.

Applications in which a "Notice of Incomplete Application" has been mailed will be retained in OIPE to await action by the applicant since further action by the applicant is necessary for the application to be accorded a filing date. Unless applicant completes the application, or files a petition under 37 CFR **1.53(e)** with the petition fee set forth in 37 CFR **1.17(f)**, or files a petition under 37 CFR **1.57(a)(3)** with the petition fee set forth in 37 CFR **1.17(f)**, within the period set in the "Notice of Incomplete Application," the application will be processed as an incomplete application under 37 CFR **1.53(e)**.